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EXAMINER

MATTISON, LORI K

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/579,814  
Filing Date: October 13, 2006  
Appellant(s): PANIN, GIORGIO

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Silvia Salvadori  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 19, 2011 appealing from the Office action mailed February 03, 2011.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 16-38 and 42.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

**(8) Evidence Relied Upon**

EP 1074243	PANTINI	07-2001
6066311	CHEETHAM	05-2000
5945000	RANDALL	08-1999
6015548	SIDDIQUI	01-2000
6007796	MENZEL	12-1999

SCHLIEMANN-WILLERS. Acta Derm Venereol, vol 81 ( 2001), pp.392-394.

Fomblin HC/P2-1000 Product Information Sheet. Solvay Solexis (Sept. 2005).  
[http://www.solvaysolexis.com/static/wma/pdf/8/2/0/2/SEPT%202005%20PDS%20HC-P3-1000%20\(2\).pdf](http://www.solvaysolexis.com/static/wma/pdf/8/2/0/2/SEPT%202005%20PDS%20HC-P3-1000%20(2).pdf). Accessed 5/20/2009.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**9A**

Claim 16, 20, 21, 23 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,074,243 (PANTINI, 2000) in view of US Patent No. 6,066,311 (CHEETHAM, 2000)

With respect to instant claims 16 and 21, PANTINI teaches the composition of Example 17a is a cosmetic formulation, a sun cream (i.e. a cosmetic composition for topical use; page 10, paragraphs 77-78). The composition comprises the stabilizing agent the perfluoropolyether phosphates Fomblin HC/P2-1000 and Fomblin HC/R. With respect to instant claim 20, Example 17a utilizes Fomblin HC/P2-1000 and Fomblin HC/R in an amount of 3.0%. With respect to claim 38, PANTINI teaches the composition is a cream.

PANTINI does not teach inclusion of polyphenols in his composition as set forth by instant claim 16.

Example 3 of CHEETHAM teaches caffeic acid (i.e. a polyphenol) has *advantageous* UV absorption qualities and embodies caffeic acid in a sunscreen composition in an amount of 2% by weight (col. 12, lines 30-55).

With respect to claims 16 and 23, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added 2% caffeic acid to the sunscreen of PANTINI because CHEETHAM teaches that the caffeic acid polyphenol is an advantageous UV absorber that may be used in sunscreens.

With respect to claim 21, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention to have included at least one perfluoropolyether phosphate in the composition of Example 17a of PANTINI in an amount of between 0.2 and 1.0% because PANTINI teaches use of Fomblin HC/R in an amount of 1%.

With respect to claim 23, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention to have included caffeic acid (i.e. a polyphenol) in an

amount of 2% by weight in PANTINI'S sun cream composition because CHEETHAM teaches inclusion of 2% by weight caffeic acid in sunscreens.

**9B**

Claims 17, 18, 19, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI and CHEETHAM as applied to claims 16, 20, 21, 23 and 38 above, and further in view of in view of SCHLIEMANN-WILLERS as published in *Acta Dermato-Venereologica* in 2001 and as evidenced by the Fomblin HC/P2-1000 product information sheet as dated 09/2005 by Solvay Solexis.

With respect to claim 17, PANTINI teaches the perfluoropolyether diphosphate used in his invention has the general formula:

$R_f[CF_2CH_2-O-(CHR_1CHR_2O)_n-P(O)(OH)_2]_x$  (pg. 2 line 40-end; pg. 3 (in its entirety) and pg. 4).

With respect to claims 17 and 22, PANTINI teaches Fomblin HC/P2-1000 was present in the composition of Example 17a in an amount of 2.0%.

PANTINI does not teach the exact chemical formula perfluoropolyether diphosphate, Fomblin HC/P2-1000, which is used in the examples. Thus PANTINI does not teach the  $R_f$ ,  $x$ ,  $R_1$ ,  $R_2$ , and,  $a$ ,  $b$ , and  $n$  moieties and integers set forth by instant claims 17 and 18.

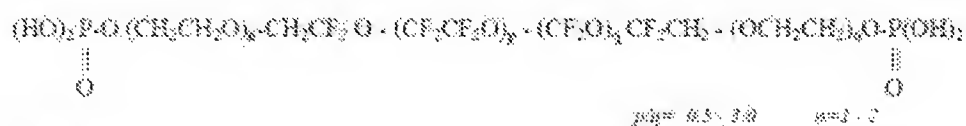
PANTINI does not teach Fomblin HC/P2-1000 has the chemical structure of Formula II.

PANTINI does not teach a polyphenol content between 0.1 and 5% the weight of the total composition as set forth by instant claim 24.

SCHLIEMANN-WILLERS teaches Fomblin HC/P2 1000 and Fomblin HC/P2 2000 have the CAS number 200013-65-6 and differ just with respect to molecular weight (i.e. 1000 vs. 2000; pg. 393, col. 1, ¶ 5). As evidenced by the product information sheet for Fomblin HC/P2-1000, Fomblin HC/P2-1000 has the formula (pg. 1)

## FOYBLIN® HC/P2-1000

### Chemical Structure



**Abstract**

<b>EWG Name:</b>	Poly(perfluorooctylmethoxy Difluoroethyl) PEG Phosphate
<b>Other Chemical Names:</b>	Perfluoropolyether phosphate, Perfluoropolyether acid phosphate, Perfluoropolyether PEG phosphate, PFPE-1000 phosphate
<b>CAS Number:</b>	200013-65-6
<b>CAS Name:</b>	Diphosphoric acid, polymers with ethoxylated reduced Me esters of reduced poly(methyl oxidized tetrafluoroethylene
<b>EINECS Number:</b>	Not applicable (since it is a polymer)

With respect to instant claim 18, the examiner notes the molecular weight of all the constituents of FOMBLIN HC/P2-1000, when  $n=1$ , absent the constituents of  $R_f = 426$ . Thus  $M_n = 574$ .

With respect to claim 17, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included a perfluoropolyether diphosphate with the formula  $R_f[CF_2CH_2-O-(CHR_1CHR_2O)_n-P(O)(OH)_2]_x$  wherein  $x=2$ ,  $R_1$  and  $R_2$  are H,  $n=1$ , and  $R_f = (CF_2O)$  and  $(CF_2CF_2O)$  because PANTINI teaches the sun cream of Example 17a comprises Fomblin HC/P2-1000 and Fomblin HC/P2-1000 has the formula

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$R_f[CF_2CH_2-O-(CHR_1CHR_2O)_n-P(O)(OH)_2]_x$  wherein  $x=2$ ,  $R_1$  and  $R_2$  are H,  $n=1$ , and  $R_f = (CF_2O)$  and  $(CF_2CF_2O)$  as taught by SCHLIEMANN-WILLERS and as evidenced by the Fomblin HC/P2-1000 product information sheet.

With respect to claim 18, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included a perfluoropolyether diphosphate with a  $R_f = -(CF_2O)_a-(CF_2CF_2O)_b-$  wherein  $b/a$  is between 0.5- 3.0 and  $M_n = 574$  because PANTINI teaches the sun cream of Example 17a comprises Fomblin HC/P2-1000 and Fomblin HC/P2-1000 has  $R_f = -(CF_2O)_a-(CF_2CF_2O)_b-$  wherein  $b/a$  is between 0.5- 3.0 and  $M_n = 574$  as taught by SCHLIEMANN-WILLERS and as evidenced by the Fomblin HC/P2-1000 product information sheet.

With respect to instant 19, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included a perfluoropolyether diphosphate with a formula that is  $-CF_2-O(CF_2CF_2O)_b(CF_2O)_a-CF_2-[CH_2-(OCH_2CH_2)_nO-PO(OH)_2]_2$  wherein  $n=1$  or 2 and  $b/a = 0.5-3.0$  because PANTINI teaches that the sun cream of Example 17a comprises Fomblin HC/P2-1000 and Fomblin HC/P2-1000 has a formula that is  $-CF_2-O(CF_2CF_2O)_b(CF_2O)_a-CF_2-[CH_2-(OCH_2CH_2)_nO-PO(OH)_2]_2$  wherein  $n=1$  or 2 and  $b/a = 0.5-3.0$  as taught by SCHLIEMANN-WILLERS and as evidenced by the Fomblin HC/P2-1000 product information sheet.

With respect to claim 22, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included a perfluoropolyether diphosphate in an amount of 2.0% weight of the total composition because PANTINI teaches that the sun cream of Example 17a comprises Fomblin HC/P2-1000 in an amount of 2.0% and



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Fomblin HC/P2-1000 is a perfluoropolyether diphosphate as taught by SCHLIEMANN-WILLERS and as evidenced by the Fomblin HC/P2-1000 product information sheet.

With respect to claim 24, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included the polyphenol, caffeic acid, in the composition of PANTINI in an amount of 2% because CHEETHAM teaches that caffeic acid has advantageous UV absorption qualities Example 3 of and embodies it use in an amount of 2.0% in sunscreen composition.

### **9C**

Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, and as evidenced by the Fomblin HC/P2-1000 product information sheet, as applied to claims 16-24 and 38 above and further in view of US Patent No. 5,945,090 (RANDALL, 1999).

PANTINI does not teach inclusion of vitamin E in the sun cream of Example 17a, as set forth by instant claims 25-27.

PANTINI does not teach inclusion of vitamin E in the sun cream of Example 17a in an amount of 0.5-10% as set forth by instant claims 28-30.

RANDALL teaches vitamin E acetate improves skin smoothness and aids in prevention of free radical damage caused by the sun (col. 3, lines 55-end). RANDALL embodies use of vitamin E acetate in an amount of 0.5% of the SPF 8 sunscreen formulation of Example 1 (col. 4, lines 5-end; col. 5, lines 1-10).

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With respect to instant claims 25-27, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included Vitamin E acetate in the sun cream taught by PANTINI because RANDALL teaches vitamin E acetate improves skin smoothness and aids in prevention of free radical damage caused by the sun and embodies its use in a sunscreen.

With respect to instant claims 28-30, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have included vitamin E acetate in the sun cream taught by PANTINI in an amount of 0.5% because RANDALL teaches vitamin E acetate improves skin smoothness and aids in prevention of free radical damage caused by the sun and embodies its use in a sunscreen in an amount of 0.5%.

## **9D**

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, AND RANDALL, as evidenced by the Fomblin HC/P2-1000 product information sheet as applied to claims 16-30 and 38 above, and further in view of US Patent No. 6,015,548 (SIDDIQUI, 2000) .

PANTINI does not teach inclusion of Vitamin A in the sun cream of Example 17a as set forth by instant claims 35 and 36.

SIDDIQUI teaches vitamin A is a skin protectant which reduces production of PGE<sub>2</sub> or increases skin viability when topically applied (col. 5, lines 40-55). SIDDIQUI embodies use of vitamin A palmitate in water proof SPF 20 sunscreen in Examples 3 and 4 (col. 14, lines 1-60).

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With respect to instant claims 35 and 36, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added vitamin A palmitate to the sun cream composition of Example 17a of PANTINI because SIDDIQUI teaches that vitamin A palmitate is a skin protectant used in sunscreen formulations which reduces production of PGE<sub>2</sub> or increases skin viability when topically applied.

### 9E

Claims 31-34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, RANDALL, and SIDDIQUI as evidenced by the Fomblin HC/P2-1000 product information sheet as applied to claims 16-30, 35, 36 and 38 above, and further in view of US Patent No. 6,007,796 (MENZEL,1999).

PANTINI does not teach inclusion of vitamin C (ascorbic acid) in the sun cream of Example 17a as set forth by instant claims 31 and 32.

PANTINI does not teach inclusion of vitamin C (ascorbic acid) in the sun cream of Example 17a in an amount between 0.1 and 10% by weight as set forth by instant claims 33 and 34.

PANTINI does not teach inclusion of vitamin A in the sun cream of Example 17a as set forth by instant claim 37.

SIDDIQUI teaches vitamin C is an antioxidant that may be added to sunscreens to improve cellular viability, reduce production of PGE<sub>2</sub> and scavenge free radicals from skin (col. 5, lines 10-30; col. 6, lines 5-30)

MENZEL teaches a composition which is a self-tanning but has a sunscreen effect (title). MENZEL teaches inclusion of an antioxidant in the composition in an amount of 0.01 to 5.0% with ascorbic acid (i.e. vitamin C) being one of the recited antioxidants taught for inclusion and is embodied in the SPF 6-8 cream Example 1 (col. 2, lines 55-65; col. 4, lines 1-55).

With respect to claims 31 and 32, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added vitamin C (ascorbic acid) to the sun cream composition of Example 17a of PANTINI because SIDDIQUI and MENZEL teach vitamin C is an antioxidant which may be added to SPF formulations (i.e. sunscreens) to scavenge free radicals and improve cellular viability.

With respect to claims 33 and 34, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added vitamin C (i.e. ascorbic acid) to the sun cream composition of Example 17a of PANTINI because SIDDIQUI and MENZEL teach vitamin C (i.e. ascorbic acid) is an antioxidant which may be added to SPF formulations (i.e. sunscreens) to scavenge free radicals and improve cellular viability that is used in SPF compositions in an amount of 0.01 to 5.0% as taught by MENZEL.

With respect to instant claim 37, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added vitamin A palmitate to the sun cream composition of Example 17a of PANTINI because SIDDIQUI teaches vitamin A palmitate is a skin protectant used in sunscreen formulations which reduces production of PGE<sub>2</sub> or increases skin viability when topically applied.

**(10) Response to Argument**

**10A**

In the traverse of claims 16, 20-21, 23 and 38, Appellant argues the use of stabilizing (per)fluoropolyethers in the invention is to prevent oxidative degradation of polyphenols (Brief, pg. 9, ¶ 3). Appellant argues the stabilized (per)fluoropolyether emulsions of PANTINI are “stabilized” in the sense that the emulsions do not separate and PANTINI does not recognize the need to stabilize polyphenols against oxidative degradation (Brief, pg. 9, ¶ 4; pg. 10, ¶s 1 and 6; pg. 12, ¶ 2).

In response, M.P.E.P. § 2144 IV states "Rationale Different From Applicant's is Permissible". "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem." In the instant case, PANTINI teaches *three* cosmetic formulations that are sun creams which comprise (per)fluoropolyethers (¶s 11-82). PANTINI claims these cosmetics for “the protection against sun radiations...” and claims inclusion of sun filters (PANTINI’s claims 12 and 18). CHEETHAM explicitly teaches caffeic acid (i.e. a polyphenol) has *advantageous* UV absorption qualities (CHEETHAM, col. 12, lines 30-55); CHEETHAM even *embodies* use of caffeic acid (i.e. polyphenol) in a *sunscreening composition* (i.e. a sun cream; CHEETHAM, col. 12, lines 30-55). Thus, the ordinary skilled artisan would have been motivated to add the caffeic acid (i.e. polyphenol) taught by CHEETHAM to the sunscreening composition taught by PANTINI because caffeic acid (i.e. polyphenol) is an *advantageous* UV absorber utilized in sunscreening compositions as taught and *embodied* by CHEETHAM. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art

cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Accordingly, since the combination of PANTINI and CHEETHAM teach the recited reagents in the recited amounts, the composition would necessarily have the characteristic of preventing oxidative degradation of the polyphenol (i.e. caffeic acid).

Further, the stabilizing (per)fluoropolyether used by Appellant and taught by PANTINI was Fomblin HC/P2-1000 (instant specification, pg. 9, lines 15-20; PANTINI-Example 17a, ¶ 78). Since the product used by the Appellant and the product taught by PANTINI are the same chemical and have the same chemical structure, the Fomblin HC/P2-1000 (per)fluoropolyether of PANTINI is necessarily stabilizing. Notably, Appellant has not provided evidence the composition taught by PANTINI in view of CHEETHAM is not stabilizing and does not prevent the oxidative degradation of the polyphenol. “It is not invention to perceive that the product which others had discovered had qualities they failed to detect.”); In re Wiseman, 596 F.2d 1019, 1023 [201 USPQ 658] (CCPA 1979) (rejecting the notion that “a structure suggested by the prior art, and, hence, potentially in the possession of the public, is patentable ... because it also possesses an inherent, but hitherto unknown, function which [patentees] claim to have discovered. This is not the law. A patent on such a structure would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art.”).

Appellant argues PANTINI teaches a myriad of purposes for the composition (Brief, pg. 11, last ¶). CHEETHAM only discloses use of caffeic acid and its derivatives as sunscreen additives (Brief, pg. 10, ¶ 2). The ordinary skilled artisan would not know for which purpose

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they were adding the caffeic acid (Brief, pg. 10, ¶ 7; pg. 12, ¶ 1). Thus, there would be no motivation of adding the caffeic acid taught by CHEETHAM to the deodorant or nail-varnish composition taught by CHEETHAM (Brief, pg. 10, ¶ 7). Impermissible hindsight has been performed (Brief, pg. 11, ¶1; pg. 12, ¶ 2).

In response to Appellant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, PANTINI explicitly teaches a cosmetic formulation which is a sun cream (pg. 10, ¶s 77-78). PANTINI teaches inclusion of sun filters in the compositions of his invention (¶ 30). PANTINI exemplifies three sun creams comprising (per)fluoropolyethers (¶s 11-82). PANTINI even claims cosmetics for "the protection against sun radiations..." (PANTINI's claim 12). PANTINI claims the compositions comprise sun filters (PANTINI's claim 18). CHEETHAM explicitly teaches caffeic acid (i.e. a polyphenol) has *advantageous* UV absorption qualities (CHEETHAM, col. 12, lines 30-55); CHEETHAM even *embodies* use of caffeic acid (i.e. polyphenols) in a *sunscreening composition* (i.e. a sun cream; CHEETHAM, col. 12, lines 30-55). Thus, the ordinary skilled artisan would have been motivated to add the caffeic acid (i.e. polyphenol) taught by CHEETHAM to the sunscreening composition taught by PANTINI

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because caffeic acid (i.e. polyphenol) is an *advantageous* UV absorber utilized in sunscreens compositions as taught by CHEETHAM.

In response to the allegation the ordinary skilled would not have known to which composition of PANTINI to add the caffeic acid (i.e. polyphenols), Appellant is reminded PANTINI explicitly teaches use of sun filters in the compositions of his invention and embodies a sun cream with the UV absorber octylmethoxycinnamate (§§ 30, and 77-78). Indeed, PANTINI exemplifies three sunscreen compositions (§§ 77-82). As such, the ordinary skilled artisan would be quite clear as to where the caffeic acid (i.e. polyphenols) may be applied (e.g. any PANTINI composition which embodies use of a UV absorber).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, PANTINI taught a sun cream comprising (per)fluoropolyethers (§§ 77 and 78). PANTINI teaches and claims inclusion of sun filters (§ 30, PANTINI's claim 18). CHEETHAM explicitly teaches caffeic acid has *advantageous* UV absorption qualities (i.e. caffeic acid is a sun filter) and even *embodies* use of caffeic acid in a *sunscreening composition* (CHEETHAM, col. 12, lines 30-55). Thus, one of ordinary skill in the art would have been motivated to add the caffeic acid (i.e. polyphenol) taught by CHEETHAM to the sunscreens composition taught by PANTINI in order to protect the skin against



ultraviolet light from the sun because caffeic acid (i.e. polyphenol) is an advantageous UV filter. The addition of the advantageous UV absorber, caffeic acid, to the sun cream taught by PANTINI is based solely on the teachings and knowledge within the level of ordinary skill at the time of the invention.

Appellant argues there is no motivation to add caffeic acid to a sun cream which already comprises UV filters (Brief, pg. 11, ¶ 2; pg. 12, ¶s 1 and 2).

In response to the argument there is no motivation to add caffeic acid to a sun cream which already comprises UV filters, PANTINI exemplifies use of two or more UV filters together in the sun creams for Example 17a and Example 17c. Example 17a has two chemical UV filters (i.e. butylmethoxybenzoylmethane and octylmethoxycinnamate; 78). Example 17c has two chemical UV filters and one physical UV filter (i.e. butylmethoxybenzoylmethane, octylmethoxycinnamate, and titanium dioxide). Thus, the ordinary skilled artisan would be motivated to add caffeic acid (i.e. a polyphenol) since caffeic acid is an advantageous UV absorber (CHEETHAM, col. 12, lines 30-55).

Appellant argues PANTINI and CHEETHAM do not recognize the use of including stabilizing (per)fluoropolyethers to solve the problem of oxidative degradation of polyphenols (Brief, pg. 11, ¶ 3; pg. 12, ¶2).

In response, an invention may be obvious for alternative reasons ('otherwise obvious'). "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem" (See M.P.E.P. § 2144 IV). As discussed above PANTINI teaches *three* sun creams formulations which comprise

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(per)fluoropolyethers (§s 11-82). PANTINI claims inclusion of sun filters in these cosmetics and claims use of the compositions for “the protection against sun radiations...” (PANTINI’s claims 12 and 18). CHEETHAM explicitly teaches caffeic acid (i.e. a polyphenol) has *advantageous* UV absorption qualities and *embodies* use of caffeic acid (i.e. polyphenol) in a *sunscreening composition* (i.e. a sun cream; CHEETHAM, col. 12, lines 30-55). Thus, the ordinary skilled artisan would have been motivated to add the caffeic acid (i.e. polyphenol) taught by CHEETHAM to the sunscreening composition taught by PANTINI because caffeic acid (i.e. polyphenol) is an *advantageous* UV absorber utilized in sunscreening compositions as taught and *embodied* by CHEETHAM. Since the combination of PANTINI and CHEETHAM teach the recited reagents in the recited amounts, the composition would necessarily have the characteristic of preventing oxidative degradation of the polyphenol (i.e. caffeic acid). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

**10B**

In the traverse of the rejection of claims 17-19, 22, 24 and 42, Appellant argues claim 16 is patentable over the combination of PANTINI and CHEETHAM (Brief, pg. 13, ¶ 1). Appellant argues claim 16 is not rejected over the combination of PANTINI and CHEETHAM in view of SCHLIEMANN-WILLERS as evidenced by FOMBLIN (Brief, pg. 13, ¶ 1). Thus, claims 17-19, 22, 24 and 42 are patentable (Brief, pg. 13, ¶ 1).

In response, for the reasons set forth above, claim 16 is not patentable. For the reasons set forth above, claims 17-19, 22, 24 and 42 are not patentable over PANTINI and CHEETHAM in view of SCHLIEMANN-WILLERS as evidenced by FOMBLIN.

#### **10C**

In the traverse of the rejection of claims 25-30, Appellant argues claim 16 is patentable over the combination of PANTINI and CHEETHAM (Brief, pg. 14, ¶ 1). Appellant argues claim 16 is not rejected over the combination of PANTINI, CHEETHAM, SCHLIEMANN-WILLERS as evidenced by FOMBLIN and further in view of RANDALL (Brief, pg. 14, ¶ 1). Thus, claims 25-30 are patentable (Brief, pg. 14, ¶ 1).

In response, for the reasons set forth above, claim 16 is not patentable. For the reasons set forth above, claims 25-30 are not patentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS as evidenced by FOMBLIN and further in view of RANDALL.

#### **10D**

In the traverse of the rejection of claims 35-36, Appellant argues claim 16 is patentable over the combination of PANTINI and CHEETHAM (Brief, pg. 15, ¶ 1). Appellant argues claim 16 is not rejected over the combination of PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, RANDALL as evidenced by FOMBLIN and further in view of SIDDIQUI (Brief, pg. 15, ¶ 1). Thus, claims 35 and 36 are patentable (Brief, pg. 15, ¶ 1).

In response, for the reasons set forth above, claim 16 is not patentable. For the reasons set forth above, claims 35 and 36 are not patentable over PANTINI, CHEETHAM,

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SCHLIEMANN-WILLERS, RANDALL as evidenced by FOMBLIN and further in view of SIDDQUI.

**10E**

In the traverse of the rejection of claims 31-34 and 37, Appellant argues claim 16 is patentable over the combination of PANTINI and CHEETHAM (Brief, pg. 16, ¶ 1). Appellant argues claim 16 is not rejected over the combination of PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, RANDALL, SIDDQUI as evidenced by FOMBLIN and further in view of MENZEL (Brief, pg. 16, ¶ 1). Thus, claims 31-34 and 37 are patentable (Brief, pg. 16, ¶ 1).

In response, for the reasons set forth above, claim 16 is not patentable. For the reasons set forth above, claims 31-34 and 37 are not patentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, RANDALL, SIDDQUI as evidenced by FOMBLIN and further in view of MENZEL

For the above reasons, it is believed that the rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/LORI K MATTISON/

Examiner, Art Unit 1619

September 23, 2011

Conferees:

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